



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,261	12/19/2000	Gary R. McLuen	NEI-00103	7751

7590 01/10/2005

Jonathan O. Owens
Haverstock & Owens LLP
162 North Wolfe Road
Sunnyvale, CA 94086

EXAMINER

SINES, BRIAN J

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Office Action Summary

Application No.

09/742,261

Applicant(s)

MCLUEN ET AL.

Examiner

Brian J. Sines

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-26 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26 and 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 24, 26, 35 and 38 – 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Zuellig et al. (US 6,126,904) (hereinafter “Zuellig”). Zuellig teaches devices and methods for the synthesis of combinatorial chemical libraries. As shown in figures 3 and 7A, Zuellig teaches a synthesizer apparatus comprising a first and second bank of vials (reaction vessels 30), wherein each bank of vials comprise first and second drains (exhaust passage 220), respectively. Zuellig further teaches an apparatus comprising: (a) a pressurizing system (common liquid line 50 & common gas line 60) for creating a pressure differential within either one of a first bank of vials or a second bank of vials; and (b) a first waste tube (extension passageway 610) capable of engaging a first drain to purge material from the first bank of vials and the second drain to purge material from the second bank of vials. Zuellig teaches that the introduction of gases into the plurality of reaction vessels 30 facilitates draining and purging procedures (see col. 10, lines 52 – 67). Zuellig indicates that the fluid connections may be in the form of tubes (see col. 6, lines 27 – 32). As shown in figures 3 and 7A, Zuellig teaches a secondary or a plurality of vials (reaction vessels 30), wherein each vial additionally comprise a waste tube (extension passageway 610). Zuellig further indicates that purging operations or different synthesis processes may be

Art Unit: 1743

performed separately and selectively using the two sets of reaction vessels 30 (see col. 8, lines 51 – 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 25, 36, 37, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuellig in view of Kath et al. (US 5,882,601) (hereinafter “Kath”). As discussed above, Zuellig teaches devices and methods for the synthesis of combinatorial chemical libraries. Zuellig does not specifically teach the further incorporation of a flexible drain seal, as recited in the instant claims. However, Zuellig does indicate the desirability of incorporating air-tight seals for the fluidic connections within the apparatus (see col. 9, lines 16 – 34). Kath teaches the incorporation of flexible seals, such as gaskets or o-rings which facilitate an air-tight seal between fluidic connections in chemical processing apparatus (see col. 3, lines 52 – 54). Hence, a person of ordinary skill in the art would have recognized the suitability of incorporating such a

Art Unit: 1743

sealing means within an apparatus for chemical processing. In addition, as shown by Kath, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success of incorporating such a flexible sealing means within a chemical processing apparatus for facilitating the effective sealing of the fluidic connections within the apparatus. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate such a sealing means within the apparatus of Zuellig for facilitating an effective flexible seal, as recited in the instant claims.

Response to Arguments

Applicant's arguments with respect to claims 24 – 26 and 35 – 42 have been considered, but are moot in view of the new ground(s) of rejection.

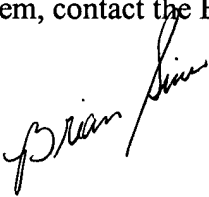
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Brian [unclear]", is written diagonally across the page.